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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,129	05/31/2000	Scott T. Hughes	A0614	3846

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EXAMINER	
COPPOLA, JACOB C	
ART UNIT	**PAPER NUMBER**
3621	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/585,129	HUGHES ET AL.	
	Examiner	Art Unit	
	JACOB C. COPPOLA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This action is in reply to the USPTO's Board of Patent Appeals and Interferences ("Board") decision mailed 18 June 2008 ("June 2008 Board Decision").

2. In the June 2008 Board Decision the Board reversed the final rejection of claims 1-10.

3. Claims 1-10 are currently pending and have been examined.

4. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.

5. This Office Action is given Paper No. 20080714. This Paper No. is for reference purposes only.

6. The Examiner of record has changed. Please indicate Jacob C. Coppola on any future correspondence. Contact information for Examiner Coppola may be found at the end of this Office Action.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 6-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

9. Regarding claims 6-10:

a. The system of claim 6, and all dependent claims thereof, is directed to a network-based system. "System" is commonly used to denote a machine. Here, the claim is not directed to a machine, but rather to a program or code. Network-based applications, programs and code are not statutory subject matter. Alternatively, processes and "computer-executable programs tangibly embodied on a computer readable medium" may be considered statutory subject matter under 35 U.S.C. §101.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Merriman et al. (U.S. 5,948,061 A) ("Merriman"), in view of Abgrall (U.S. 6,373,498 B1) ("Abgrall").

12. Regarding claims 1 and 6:

b. Merriman discloses *a method of operating a content delivery system for distributing advertising content* ("methods and apparatuses for targeting the delivery of

advertisements") *to users of personal computers* (user's browser **16**), (abstract, figure 1, figure 2, and associated text).

c. Additionally, Merriman discloses the following limitations:

i. collecting identification data ("user identification") *from a network of personal computers* ("the user is a computer on an IP Network" and "users") (C3, L24 - C4, L55; and figure 1 and associated text);

ii. *receiving the advertising content* (via "advertising process") *from an advertiser* (C4, L20+, figure 1, and associated text);

iii. *formatting the advertising content for storage* ("advertisement... are stored within ad server process **19**") *and display in the personal computer* (C4, L20+); *and*

iv. *distributing, using the collected identification data, the formatted advertising content to the personal computers* ("upon receiving") (C3, L52 and C4, L25-30).

d. Merriman does not specifically disclose the following limitations:

v. wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.

e. Abgrall, however, teaches the following limitations:

vi. wherein the personal computers (user computer $\mathbf{40_1}$ through user computer $\mathbf{40_N}$) *are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user*

selected application environment ("content that was previously downloaded... is then displayed, **prior to loading and/or execution of the operating system**") (C3, L54 - C4, L31; and C9, L25+).

f. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the personal computers of Merriman to include the functionality of periodically receiving and storing advertising content and storing advertising content and displaying the advertising content while or before bootloading a user selected application environment, as disclosed by Abgrall. One would have been motivated to do so because "the boot-up and shut-down images as displayed by the OS are normally not useful to the user and merely contain routine messages. Since the time to boot up and shut down is sufficiently long for the system to display more informative images, it is desirable to be able to display images other than the standard logos of the operating system", such as advertisements (Abgrall, "Background"; and C3, L54 - C4, L31).

13. Regarding claims 2, 3, 7, and 8:

g. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:

vii. *wherein the identification data comprises a unique identifier* ("IP Address")*/internet protocol* ("HTTP") *that is associated with one of the personal computers* ("the user is a computer on an IP Network" and "users") (C3, L24 - C4, L55).

14. Regarding claims 4 and 9:

h. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:

viii. *receiving preference data from the personal computers* ("[t]he derive profile process **52** is how the advertisement server gathers information about individual users or TCP/IP networks for individual users") (C3, L24 - C4, L55); *and*

ix. *selecting the advertisement data that is to be distributed, at least in part, based upon the received preferences* ("[i]ncluded in each message **23**... are: (i) the user's IP address..." and "upon receiving the message **23**, the advertising server process **19** determines which advertisement or other object to provide to user's browser") (Merriman, C3, L5-63 and C4, L20+).

15. Regarding claims 5 and 10:

i. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:

x. *associating a fee with data representative of the advertiser* (Merriman, C2, L59+); *and*

xi. *storing the fee in a storage device* (Merriman, C2, L59+).

16. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations

within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

17. In the event that a reviewing body finds that claimed the invention is *not* obvious as noted above and in light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/or phrases "for," "adapted to," or other functional language (*e.g.* see claim 6 which recites "a collection module *for* collecting... a formatting module *for* formatting") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. This is an alternative argument. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (*C.*), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

18. Applicants have lexicographically defined "bootloading." See June 2008 Board Decision, page 2. The Examiner has examined the claims with this definition.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: Anderson et al. (U.S. 6,578,142 B1) discloses a method and apparatus for automatically installing and configuring software on a computer.

20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/
Examiner, Art Unit 3621
July 14, 2008

AF Fischer 10/3/08

Andrew J. Fischer
Supervisory Patent Examiner, Art Unit 3621

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